REMARKS

The present application included pending claims 1-27, all of which have been rejected. By this Amendment, new claims 28-53 have been added.

Claims 21 and 22 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 2001/0021994 ("Nash"). Claims 1-20 and 23-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nash in view of U.S. 7,065,778 ("Lu"). The Applicants respectfully traverse these rejections for at least reasons previously discussed during prosecution and the following:

I. Nash Does Not Anticipate Claims 21 And 22

The Applicants first turn to the rejection of claims 21 and 22 as being anticipated by Nash. Nash "relates to a television system and to television transmission apparatus and to television receiving apparatus for use in such a system." Nash at [0001]. In particular, Nash discloses the following:

> It is an object of the invention to enable the provision of a method of presenting information to a viewer which contains both material which has been explicitly gleaned from either the viewer's viewing habits or direct inputs by the viewer and material which may be inferred as being of possible interest to the viewer but outside the normal viewing habits.

Id. at [0004].

A. Nash Does Not Describe "Automatically Selecting Media According To The User Profile"

Nash discloses automatic selection of advertisements, but such automatic selection is provided through "rating information" determined by reviewers that are independent of the user:

> Also, the **rating information** may be employed by a software agent, in conjunction with the details of the user's preferences, **to automatically select potentially interesting advertisements for the user to view**.

Id. at [0008] (emphasis added). As such, Nash is clear that "automatic selection" of "potentially interesting advertisements" is provided from "rating information," which, as noted below, is determined through independent reviewers.

> By making the rating of an advertisement by one or more reviewers of the quality of the advertisement or the quality of the product or service promoted by the advertisement one of the factors on which the advertisement selection and/or suggestion is made, those advertisements which are highly rated by one or more of the reviewers may be suggested to the viewer even if they do not satisfy other selection criteria.

Id. at [0010].

Nash is clear that rating information determined by the independent reviewers controls advertisement selections/suggestions:

> The invention further provides a television receiving device for receiving television advertisements and **data signals** transmitted by television transmitting apparatus, said receiving device comprising... a processor arranged to select and/or suggest advertisements for a viewer to receive, said selection and/or suggestion being based on information entered by a user and/or derived from monitoring the viewing habits of the user, in which **the data signals** include **data representing the individual ratings of a particular program by a plurality of reviewers and that said selection is further based on the rating accorded by one or more of the reviewers.**

Id. at [0019] (emphasis added). Thus, while Nash discloses that selection/suggestion of an advertisement is based on information entered by a user and/or derived from his/her viewing habits, the suggestion/selection is ultimately determined by ratings from independent reviewers. Again, as noted above, "automatic select[ion of] potentially interesting advertisements" is provided through the "rating information." *See id.* at [0008].

The Applicants respectfully submit, however, that Nash does not describe, teach, or suggest "automatically selecting media according to [a] user profile," as recited in claim 21. Thus, for at least this reason, Nash does not anticipate, or render unpatentable, claims 21, 22 or any of the claims that depend therefrom.

The Office Action states the following:

> Nash teaches that advertisements can be presented to a user based on the user's viewing habits or with the details of the user's preference. The Applicant's assertion is that while Nash does teach selection/suggestion of an advertisement is based on information entered by a user and/or derived from his/her viewing habits, the suggestion/selection is ultimately determined by rating from independent reviewers. However, the claim language "automatically selecting media according to the user profile" does not limit the inclusion of additional selecting factors. It is therefore the participation of the user's profile which consists of the user inputs or viewing habits to which correspond to advertisements, can be presented accordingly.

See July 26, 2007 Office Action at page 11. The Applicants respectfully note, however, that claim 21 recites, in part, "automatically selecting media according to [a] user profile." The claim does not recite "selecting media according to *at least* a user profile." Further, as detailed above, Nash, discloses "automatic select[ion of] potentially interesting advertisements" through "rating information," not the user profile. Claim 21, however, is clear that the user profile is used with respect to automatic selection. Thus, the Applicants respectfully request reconsideration of this claim rejection.

B. Nash Does Not Describe "Receiving A Request From The User For At Least A Portion Of The Identified Media"

The Applicants also respectfully submit that Nash does not describe, teach, or suggest "receiving a request **from the user** for at least a portion of the identified media," as recited in

claim 21. As discussed above, Nash discloses a method of providing advertisements to a user through rating data. Nash does not describe, teach, or suggest that a user requests a portion of an advertisement.

The Office Action relies on Nash at [0019] as disclosing "receiving a request from the user for at least a portion of the identified media." *See* July 26, 2007 Office Action at page 2 and January 10, 2007 Office Action at page 2. However, this paragraph states the following:

> The invention further provides a television receiving device for receiving television advertisements and data signals transmitted by television transmitting apparatus, said receiving device comprising a data decoder for decoding said transmitted data, a memory for storing at least some of the data decoded by said decoder, and a processor arranged to select and/or suggest advertisements for a viewer to receive, said selection and/or suggestion being based on information entered by a user and/or derived from monitoring the viewing habits of the user, in which the data signals include **data** representing the individual ratings of a particular program by a plurality of reviewers and that said selection is further based on the rating accorded by one or more of the reviewers.

Id. at [0019]. There is nothing in this paragraph that describes, teaches, or suggests "receiving a request **from the user** for at least a portion of the identified media," as recited in claim 21. Indeed, Nash does not describe, teach, or suggest a user requesting any portion of Nash's advertisements. Thus, for at least this additional reason, Nash does not anticipate claims 21 and 22.

In response, the Office Action states the following:

> Nash discloses that a processor is arranged to select and/or suggest advertisement for the viewer to receive, which the selection and/or suggestion being based on information entered by a user and/or derived from monitoring the viewing habits of the user. The entering of data by the user is the request that is received by the processor for presenting advertisement. While the **request may**

> **not be a conscious request** by the user it is still a request due to the outcome/result of the data being entered by the user.

See July 26, 2007 Office Action at page 11 (emphasis). The Applicants respectfully disagree. Initially, personal information entered by a user is not a "request." Rather, it simply is information about the user. Next, viewing habits of a user are clearly not a "request," in any sense of the term. Finally, as noted above, the Office Action indicates that Nash does not disclose a "conscious request." However, the Applicants are unaware of the nature of an "unconscious request," which the Office Action seems to suggest is found in Nash. The Applicants respectfully submit that a "request" is an affirmative act that cannot be performed "unconsciously." Thus, for at least these reasons, the Applicants respectfully request reconsideration of the claim rejections.

II. The Proposed Combination Of Nash And Lu Does Not Render Claims 1-27 Unpatentable

The Applicants next turn to the rejection of claims 1-20 and 23-27 as being unpatentable over Nash in view of Lu. Claim 21 recites, in part, a "system supporting the automatic selection of media according to a user profile." The Applicants respectfully submit that Nash does not describe, teach, or suggest "automatic selection of media according to a user profile," for at least the reasons discussed above in Section I. Thus, the Office Action has not established a *prima facie* case of obviousness with respect to claims 1-9.

A. The Office Action Does Not Establish A *Prima Facie* Case Of Obviousness With Respect To Claims 1-9

The Office Action also acknowledges the following:

> **Nash does not teach** the storage having an associated network address and server software that receives a request identifying one or both of the associated network address and/or a user identifier,

> and responds by automatically selecting media according to a user profile, the user profile corresponding to one or both of the associated network address and/or a user identifier, and delivering to the storage, via a communication network, information identifying the selected media, the information for incorporation into the user interface.

See July 26, 2007 Office Action at page 4 (emphasis added).

The Office Action then cites Lu to overcome the numerous deficiencies noted above. In particular, the Office Action states the following:

> Lu teaches server software (Figure 3 reference character 304, EPG Server) that receives a request identifying at least one of the associated network address and delivering to the storage (column 10 lines 5-22), via a communication network (Internet, Figure 3 reference character 302), information identifying the selected media (column 10, lines 10-15).

See id. Even a cursory review of this statement regarding Lu indicates that the Office Action has not accounted for various limitations that the Office Action acknowledges are missing from Nash. For example, the Office Action does not indicate that Lu discloses "automatically selecting media according to a user profile." In fact, the Office Action does not indicate that Lu discloses a "user profile" at all. Nor does the Office Action indicate that Lu discloses "information for incorporation into the user interface." **Yet, the Office Action acknowledges that Nash does not teach these limitations.** *See id.* Thus, for at least these reasons, the Office Action has not established a *prima facie* case of obviousness with respect to claims 1-9.

Claim 1 of the present application recites, in part, "server software that receives a request identifying at least one of the associated network address and a user identifier, and responds by automatically selecting media according to a user profile." Lu, on the other hand, "relates to the field of utilizing personalized video recorders and other similar types of devices to distribute

television programming." *See* Lu at column 1, lines 7-11. In particular, Lu discloses a system in which a user is able to record a show that is transmitted in another broadcast area. *See id.* at Abstract.

For example, Lu describes the following:

> Specifically, personalized video recorder 200 is coupled to the Internet 302 such that it can receive an electronic programming guide (EPG) containing worldwide television programming from an EPG server computer 304. The user of personalized video recorder 200 utilizes the EPG to request delivery of a specific television show that may not be available to him or her. Upon reception of the request from personalized video recorder 200, EPG server computer 304 locates via Internet 302 one or more personalized video recorders... situated within a broadcast region of the requested television show. Subsequently, EPG server computer 304 programs one or more personalized video recorders... to record the requested television show when it is broadcast by a television content provider.... Once the personalized video recorders... record the television show, one or more of the personalized video recorders may transmit it to EPG server computer 304 which then transmits it to the requested personalized video recorder 200. In this manner, the present embodiment enables personalized video recorder 200 to order and receive specific television shows that are unavailable from its television content provider....

Lu at column 6, lines 39-61. Thus, Lu discloses a system in which a user sends a recording request that is received by a server computer via the Internet. The server computer then locates a recorder within the broadcast region of the show, and then sends the recorded show back to the requesting user.

Neither Nash, nor Lu describes, teaches, or suggests "server software that receives a request identifying at least one of the associated network address and a user identifier, and responds by automatically selecting media according to a user profile," as recited in claim 1. The Office Action acknowledges that Nash does not disclose these limitations (*see* January 26,

2007 Office Action at page 4 ("Nash does not teach....")). Additionally, Lu merely discloses that a user of a PVR requests delivery of a specific television show, at which point a server computer arbitrarily locates another PVR in a particular broadcast area to record the show for the requesting PVR.

The Office Action relies on Lu at column 10, lines 5-22. This portion of Lu discloses the following:

> At step 512 of FIG. 5, the present embodiment causes server computer 304 to transmit programming instructions to a personalized video recorder (e.g., 200A or 200B) to record the requested television show when it is transmitted by a television content provider (e.g., television head-end 308). Furthermore, the programming instructions of step 512 may also include an Internet Protocol (IP) address of a device (e.g., personalized video recorder 200) that the personalized vide recorder (e.g., 200A or 200B) should transmit the requested television show to once it has been recorded. In step 514, after receiving the programming instructions, the present embodiment causes the personalized video recorder (e.g., 200A or 200B) to add them to its programmable task list. At step 516, the present embodiment causes the personalized video recorder (e.g., 200A or 200B) to subsequently record the requested television show during its transmission by the television content provider (e.g., television head-end 308).

Lu at column 10, lines 5-22. However, this portion of Lu merely (1) discloses how a server transmits programming instructions to a PVR and (2) indicates the IP address of the location in which the recorded show will be sent. This passage of Lu does not, however, teach or suggest "server software that receives a **request identifying at least one of the associated network address and a user identifier**, and **responds by automatically selecting media according to a user profile**," as recited in claim 1, for example.

Neither Nash, nor Lu describes, teaches, or suggests "server software that receives a request that identifying at least one of the associated network address and a user identifier, and

responds by automatically selecting media according to a user profile," as recited in claim 1. Thus, for at least these reasons, the Office Action has not established a *prima facie* case of obviousness with respect to claims 1-9. Indeed, the proposed combination does not render claims 1-9 unpatentable.

B. The Office Action Has Not Established A *Prima Facie* Case Of Obviousness With Respect To Claims 10-20

Claim 10 recites, in part, "server software that automatically selects media according to a user profile, and delivers to the storage, via a communication network, information identifying the selected media, the information for incorporation into the user interface." The Office Action acknowledges the following:

> Nash does not teach the storage having an associated network address; and server software that automatically selects media according to a user profile, and delivers to the storage, via a communication network, information identifying the selected media, the information for incorporation into the user interface.

See July 26, 2007 Office Action at page 6.

To overcome these deficiencies, the Office Action states the following:

> Lu teaches storage having an associated network address (column 10 lines 5-22), delivering media to the storage via a communication network (Internet, Figure 3 reference character 302), information identifying the selected media (column 10 lines 10-15).

See id. Again, however, the Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claims 10-20 due to the fact that **the Office Action has not shown how Lu accounts for all the limitations that are acknowledged to be missing from Nash**. A review of the statement regarding the limitations that Nash is missing and what is asserted to be disclosed in Lu reveals numerous gaps. For example, the

Office Action does not account for the automatic selection of media according to a user profile.

Moreover, neither Nash, nor Lu, describes, teaches or suggests "automatically select[ing] media according to a user profile," as recited in claim 10. Thus, for at least these reasons, the proposed combination does not render claims 10-20 unpatentable.

III. New Claims 28-53

New claims 28-53 should be in condition for allowance for at least the reasons discussed above. The fee for these new claims is calculated below:

26 additional claims in excess of 20 X $50/claim = $1300

3 new independent claims in excess of 3 X $200/claim = $600

TOTAL = $1900

IV. Conclusion

In general, the Office Action makes various statements regarding claims 1-27 and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully submit that the Office Action has not established a *prima facie* case of anticipation or obviousness with respect to any of the pending claims for at least the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the Applicants' attorney at the telephone number listed below.

The Commissioner is authorized to charge any necessary fees, including the $1900 fee for the new claims and the $790 fee for the Request for Continued Examination, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326
Attorney for Applicant

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312)775-8100